

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:

Claude Q.C. Hayes

Patent No: 6,264,854

Issue Date: July 24, 2001

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)**For: HEAT ABSORBING TEMPERATURE CONTROL DEVICES AND METHOD**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO ACCEPT AN UNAVOIDABLY DELAYED PAYMENT OF
MAINTENANCE FEE TO REINSTATE A PATENT
PURSUANT TO 37 C.F.R. 1.378(b)

Dear Sir:

On July 24, 2001, U.S. Patent No. 6,264,854 (hereinafter "'854 Patent") issued to Claude Q.C. Hayes ("Patentee"). The deadline for paying the second maintenance fee for the '854 Patent was July 24, 2009. However, Patentee unavoidably failed to meet this deadline. Patentee therefore respectfully requests that the delayed payment of the maintenance fee be accepted and the '854 Patent be reinstated under 37 C.F.R. 1.378(b). It is respectfully submitted that the entire delay for payment of the second maintenance fee was unavoidable.

Under 37 C.F.R. 1.378(b), a Petition to Accept Unavoidably Delayed Payment of Maintenance Fee and Reinstate Patent must be accompanied by: (1) the required maintenance fee set forth in 37 C.F.R. 1.20(f); (2) the surcharge set forth in 37 C.F.R. 1.20(i)(1); and (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely

payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

In support of this Petition, UConn submits the Declaration of Basam E. Nabulsi in Support of Petition Under 37 C.F.R. 1.78(b) to Accept Unavoidably Delayed Payment of Maintenance Fee and to Reinstate Patent (the "Nabulsi Declaration"), together with the following exhibits:

- EXHIBIT A: CPI docket printout for '854 Patent
- EXHIBIT B: Deposit Account printout for November 2008
- EXHIBIT C: Reporting letter related to maintenance fee payment
- EXHIBIT D: Maintenance fee printout for related patent of Patentee
- EXHIBIT E: Post-Issuance Submission in connection with '854 Patent
- EXHIBIT F: Supplemental Declaration in connection with '854 Patent
- EXHIBIT G: Maintenance Fee Reminder for '854 Patent
- EXHIBIT H: Notice of Patent Expiration for '854 Patent

In addition, in support of the present Petition, the Commissioner is hereby authorized to charge Deposit Account No. 503570 in the amounts of \$700.00 for the applicable petition fee under 37 C.F.R. 1.20(i)(1), and \$3000.00 for the maintenance fee and the surcharge fee due at 7½ years (large entity). The Commissioner is further authorized to charge any underpayments or credit any overpayments to the Deposit Account No. 503570.

REMARKS IN SUPPORT OF PETITION

Patentee respectfully submits that reinstatement of the '854 Patent pursuant to 37 CFR 1.378(b) is warranted because Patentee's failure to pay the second maintenance fee for the subject patent was unavoidable. In particular, it is noted that a "docketing error" by an employee in the performance of a clerical function supports a finding of "unavoidable delay" provided:

- a. The docketing error was the cause of the delay at issue;

- b. A business routine was in place for performing the clerical function which was reasonably relied upon to avoid errors; and
- c. The employee who erred was sufficiently trained and experienced with regard to the function and routine such that reliance upon the employee represented the exercise of due care.

See MPEP 711.03(c); *In re Patent No. 5,917,913*, 2008 Commr. Pat. LEXIS 49 (Sept. 25, 2008); *In re Egbers*, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), *rev'd on other grounds sub nom.*, *Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg*, 10 USPQ2d 1787 (D.D.C. 1988); *In re Katrapat*, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988).

The facts associated with '854 Patent clearly satisfy the "unavoidable delay" standard based on the foregoing "docketing error" guidelines. In particular and as set forth in the accompanying Nabulsi Declaration:

1. Mr. Nabulsi (the undersigned) is a partner with the law firm McCarter & English, LLP ("M&E") and has been a partner with M&E since October 1, 2003. Prior to joining M&E, Mr. Nabulsi was a partner with the law firm Cummings & Lockwood LP ("C&L") beginning in April 1998.
2. During Mr. Nabulsi's tenure at C&L, he began representing Claude Q.C. Hayes ("Hayes") in connection with intellectual property matters. In connection with the noted representation of Hayes, Mr. Nabulsi assumed responsibility for a patent portfolio that included eighteen (18) issued patents as of November 2008. In the M&E systems, each of the Hayes patents is associated with the same client number – 97661 – but is assigned its own matter number.
3. U.S. Patent No. 6,264,854 entitled "Heat Absorbing Temperature Control Devices and Method" to Hayes issued on July 24, 2001. The M&E reference number for the '854 Patent is "97661.00013".
4. The window for payment of the second maintenance fee associated with the '854 Patent opened on July 24, 2008 and closed on July 24, 2009.

5. M&E maintains a computerized docket system that is licensed from Computer Packages, Inc. ("CPI"). All entries to M&E's docket system are made by personnel trained in the use of the CPI docket system, including the creation of new docket records, the entry of upcoming deadlines and the removal of completed action items.
6. The individual responsible for maintenance fee payment and docket entries associated with the '854 Patent – Ms. Joan Simmons – is a paralegal at M&E having more than twenty five (25) years of experience in patent practice, including specifically docketing and maintenance fee payments. Ms. Simmons is intimately familiar with the operation and use of M&E's CPI docket system and electronic submissions to the USPTO, including specifically electronic payment of maintenance fees. In addition, Ms. Simmons receives ongoing training in support of her duties from M&E, and has proven to be highly reliable in performing her responsibilities, including specifically docketing and electronic maintenance fee processing.
7. Various entries associated with payment of the second maintenance fee for the '854 Patent were automatically established in M&E's CPI docket system based upon the issue date of the '854 Patent. A copy of a printout from M&E's CPI docket system showing a chronological list of due dates associated with the '854 Patent – associated with the client/matter designation of 97661.00013 -- is appended to the Nabulsi Declaration as Exhibit A. As shown on the noted CPI printout, M&E's CPI docket system included the following entries with respect to the second maintenance fee for the '854 Patent:
 - a. "Reminder 2nd MFEE due 1/24" -- Due Date: 24-Nov-2008
(Reminder)
 - b. "2nd MAINT FEE DUE" -- Due Date: 24-Jan-2009 (Due Date)
 - c. "2nd MAINT FEE DUE" -- Due Date: 24-Jul-2009 (Final)

8. As also reflected on the CPI printout appended to the Nabulsi Declaration as Exhibit A, the deadlines associated with the second maintenance fee for the '854 Patent were removed from M&E's CPI docket system on November 23, 2008. As explained in the Nabulsi Declaration, the noted deadlines associated with the second maintenance fee were removed from M&E's CPI docket system in error.
9. M&E maintains several Deposit Accounts with the U.S. Patent and Trademark Office ("USPTO") in connection with its patent-related activities. M&E's Stamford office – in which Mr. Nabulsi practices – utilizes Deposit Account No. 503570 (the "Deposit Account"). A copy of a printout associated with activities in the Deposit Account for the month of November 2008 is appended to the Nabulsi Declaration as Exhibit B.
10. As shown on the appended Deposit Account printout, the maintenance fee for U.S. Patent No. 6,238,591 (the "'591 Patent") was posted to the Deposit Account on November 24, 2008. Of note, November 24, 2008 was a "Monday" and any Deposit Account activity from the weekend, e.g., Sunday, November 23, 2008, would not be posted to the Deposit Account until Monday, November 24th.
11. When USPTO fees are paid electronically using the Deposit Account, the individual authorizing the payment identifies the "attorney docket number" to be associated with the activity. Thus, even though the '591 Patent is a distinct Hayes patent and is associated with client/matter designation 97771.00016, the individual authorizing payment of the noted maintenance fee incorrectly correlated the payment with client/matter designation 97771.00013, i.e., the '854 Patent.
12. Based on the mistaken belief that the second maintenance fee for the '854 Patent had been paid on November 23, 2008, the associated deadlines were removed from M&E's docket system on November 23, 2008. The removal of these deadlines from the CPI docket system on November 23, 2008 is reflected in the printout appended to the Nabulsi Declaration as Exhibit A.

13. Consistent with the mistaken belief that the second maintenance fee for the '854 Patent had been paid on November 23, 2008, a reporting letter was forwarded to Hayes on November 24, 2008 in connection with client/matter designation 97661.00013. A copy of the reporting letter is appended to the Nabulsi Declaration as Exhibit C.
14. The noted reporting letter is physically located in M&E's physical file for the '854 Patent, i.e., the file associated with client/matter designation 97661.00013. However, it is noted that the subject heading for the noted reporting letter references the '591 Patent. Thus, at the time that the reporting letter was dispatched to Hayes, the incorrect correlation of the '591 Patent with client/matter designation 97661.00013 was not recognized.
15. M&E's physical file for the '854 Patent (client/matter designation 97661.00013) also contains a maintenance fee printout dated November 24, 2008 reflecting payment of the maintenance fee for the '591 Patent. A copy of the maintenance fee printout is appended to the Nabulsi Declaration as Exhibit D.
16. As is apparent from the foregoing materials, the mistaken non-payment of the second maintenance fee for the '854 Patent was based on an incorrect identification of the maintenance fee paid on Sunday, November 23, 2008, which led to removal of the docketed deadlines associated with such payment from M&E's docket system.
17. As noted above, Mr. Nabulsi moved his practice from C&L to M&E in October 2003. To ensure that future USPTO communications were received by Mr. Nabulsi at M&E, steps were taken to update the USPTO records.
18. On December 5, 2005, a Post-Issuance Submission of Corrected Declaration and an executed Declaration, Power of Attorney, and Petition ("Supplemental Declaration"), were filed with the USPTO (together with a Certificate of Mailing and a return postcard). Copies of the Post-Issuance

Submission and the Supplemental Declaration are appended to the Nabulsi Declaration as Exhibit E. A copy of the return postcard reflecting receipt of the noted documents at the USPTO on December 7, 2005 is appended to the Nabulsi Declaration as Exhibit F.

19. As set forth in the Supplemental Declaration, the mailing address associated with the '854 Patent was formally changed to:

McCARTER & ENGLISH, LLP
Attn.: Angelica Brooks
CityPlace I
185 Asylum Street
Hartford, CT 06103

20. Notwithstanding the address change set forth in the Supplemental Declaration, the USPTO records were not updated as requested by Hayes.
21. Hayes learned that the '854 Patent had lapsed due to non-payment of the second maintenance fee from a licensee of the '854 Patent on November 15, 2011. Hayes immediately communicated with Mr. Nabulsi's office and an investigation as to the facts and circumstances was promptly undertaken.
22. Upon learning of the non-payment issue, Mr. Nabulsi researched the circumstances surrounding the apparent payment of the second maintenance fee in November 2008, the docketing steps taken with respect to the '854 Patent, and the reasons that Mr. Nabulsi received no communications from the USPTO with respect to the delinquent maintenance fee for the '854 Patent. Mr. Nabulsi also engaged in the requisite research concerning the standards and requirements for reinstatement of the '854 Patent.
23. With respect to the non-existence of USPTO communications concerning the delinquent maintenance fee, Mr. Nabulsi determined that the necessary information was not available at the USPTO website. Accordingly, Mr. Nabulsi arranged for physical inspection of the USPTO files for the '854 Patent to determine why Mr. Nabulsi had not received a

communication from the USPTO that the '854 Patent had entered the maintenance fee grace period and/or that the '854 Patent had lapsed.

24. A copy of the Maintenance Fee Reminder issued by the USPTO on February 2, 2009 is appended to the Nabulsi Declaration as Exhibit G, and a copy of the Notice of Patent Expiration issued by the USPTO on August 24, 2009 is appended to the Nabulsi Declaration as Exhibit H. Both of these documents were incorrectly mailed to C&L, despite the change of address set forth in the Supplemental Declaration more than three (3) years prior.
25. Based upon a thorough investigation, neither the Maintenance Fee Reminder nor the Notice of Patent Expiration was received by M&E from C&L. As a result, the opportunity to cure the above-noted error within the surcharge period or shortly after the '854 Patent lapsed was unavoidably missed through no fault of Hayes and/or his attorneys.
26. Based on the foregoing facts and circumstances, Mr. Nabulsi avers that reasonable care was taken to ensure that maintenance fees would be paid timely for the '854 Patent, and that the failure to pay the second maintenance fee was unavoidable.
27. Mr. Nabulsi further avers that the petition to accept the delayed payment of the maintenance fee in order to reinstate the '854 Patent is being promptly filed after becoming aware of the expiration of the '854 Patent and completing the requisite investigation.


Patentee respectfully submits that the foregoing facts fully satisfy the requirements associated with the "docketing error" standard for reinstatement based on an "unavoidable delay" in maintenance fee payment, and support prompt reinstatement of the '854 Patent under 37 CFR 1.378(b). Moreover, the USPTO's failure to update the mailing address for the '854 Patent – as requested by Patentee in 2005 – defeated Patentee's opportunity to take immediate corrective action with respect to the underlying docketing error, e.g., during the surcharge period, thereby further demonstrating the "unavoidability" associated

with Patentee's failure to timely pay the second maintenance fee associated with the '854 Patent.

For at least the foregoing reasons, it is respectfully submitted that the requirements of 37 CFR 1.378(b) are fully satisfied and that prompt reinstatement of the '854 Patent is proper. Prompt action to that effect is earnestly solicited.

Respectfully submitted,

Date: February 2, 2012


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